

### REMARKS

The above amendments to the above-captioned application along with the following remarks are being submitted as a full and complete response to the Office Action dated October 7, 2005. Applicants thank the Examiner for taking the time to conduct a telephone interview with the Applicants' representatives and with the undersigned on December 30, 2005.

In view of the above amendments and the following remarks, the Examiner is respectfully requested to give due reconsideration to this application, to indicate the allowability of the claims, and to pass this case to issue.

### Status of the Claims

Claims 1-16 are under consideration in this application. Claims 1, 9 and 10 are being amended, as set forth in the above marked-up presentation of the claim amendments, in order to more particularly define and distinctly claim applicants' invention, and in accordance with the changes discussed with the Examiner during the interview.

### Prior Art Rejections

The Examiner rejected claims 1-16 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,810,359 to Sakaguchi et al., in view of U.S. Patent No. 6,687,634 to Borg et al. This rejection has been carefully considered, but is most respectfully traversed.

The present invention as now recited in claim 1 is directed to a method for a third party provider to guarantee the performance of long-term capital equipment or fixtures of an owner by managing and maintaining all components of the long-term capital equipment or fixtures for a specified period of time so as to allow the owner to better plan and prioritize limited budget resources, comprising the steps of: (1) diagnosing existing conditions of the long-term capital equipment or fixtures by the provider to determine if any repairs are required to bring the long-term capital equipment or fixtures to a predetermined start-up standard of performance, said predetermined start-up standard of performance being negotiated between the owner and the provider; (2) repairing the long-term capital equipment or fixtures by the provider to reach the start-up standard if any of the existing conditions are below the predetermined start-up standard; (3) developing a maintenance schedule by the provider to perform recurrent inspections, preventive maintenance, and housekeeping on the

term capital equipment or fixtures of an owner by managing and maintaining all components of the long-term capital equipment or fixtures for a specified period of time so as to allow the owner to better plan and prioritize limited budget resources, comprising: (1) a diagnosing module for diagnosing existing conditions of the long-term capital equipment or fixtures by the provider to determine if any repairs are required to bring the long-term capital equipment or fixtures to a predetermined start-up standard of performance, said predetermined start-up standard of performance being negotiated between the owner and the provider; (2) a repairing module for repairing the long-term capital equipment or fixtures by the provider to reach the start-up standard if any of the existing conditions are below the predetermined start-up standard; (3) a maintenance schedule module for developing a maintenance schedule by the provider to perform recurrent inspections, preventive maintenance, and housekeeping on the long-term capital equipment or fixtures so as to maintain the long-term capital equipment or fixtures at a standard of performance for a specified period of time, said standard of performance being negotiated between the owner and the provider and set to within industry acceptable parameters; and (4) a warranty module for providing a warranty by the provider on the long-term capital equipment or fixtures in conjunction with the purchase by the owner of performance by the (1)-(3) modules, said providing of the warranty including transferring from the owner to the provider the technical and financial risk including costs associated with managing and maintaining all components of the long-term capital equipment or fixtures within the standard of performance during the specified period of time.

Among the advantages of the present invention, the structure and operation of the invention allows the owner to better plan and prioritize limited budget resources. For example, the present invention can by its nature be offered to users based on fixed pricing or predictable pricing or purchasing methods, such as those methods used by federal, state or local government agencies, as well as by private entities that maintain large inventories of capital equipment. The invention allows a user to better predict, plan and prioritize the limited funds and other resources that all entities, government or private, now face everyday.

In contrast to the present invention, the primary reference of Sakaguchi '359, as noted by the Examiner on page 3 of the Office Action, fails to show or suggest any warranty, let alone a warranty on any or all of the components of the capital equipment or fixtures as in the present invention. The Examiner relies on Borg '634 to show a warranty. However, this reference is in actuality directed to a system for monitoring the quality and performance of only specific serviceable components in a product (i.e., a printer or a copier). In operation,

long-term capital equipment or fixtures so as to maintain the long-term capital equipment or fixtures at a standard of performance for a specified period of time, said standard of performance being negotiated between the owner and the provider and set to within industry acceptable parameters; and(4) providing a warranty by the provider on the long-term capital equipment or fixtures in conjunction with the purchase by the owner of performance of the (1)-(3) steps, said providing of the warranty including transferring from the owner to the provider the technical and financial risk including costs associated with managing and maintaining all components of the long-term capital equipment or fixtures within the standard of performance during the specified period of time.

In another embodiment, the present invention recited in claim 9 is directed to An automated system for a third party provider to guarantee the performance of long-term capital equipment or fixtures of an owner by managing and maintaining all components of the long-term capital equipment or fixtures for a specified period of time so as to allow the owner to better plan and prioritize limited budget resources, comprising: (1) means for diagnosing existing conditions of the long-term capital equipment or fixtures by the provider to determine if any repairs are required to bring the long-term capital equipment or fixtures to a predetermined start-up standard of performance, said predetermined start-up standard of performance being negotiated between the owner and the provider; (2) means for repairing the long-term capital equipment or fixtures by the provider to reach the start-up standard if any of the existing conditions are below the predetermined start-up standard; (3) means for developing a maintenance schedule by the provider to perform recurrent inspections, preventive maintenance, and housekeeping on the long-term capital equipment or fixtures so as to maintain the long-term capital equipment or fixtures at a standard of performance for a specified period of time, said standard of performance being negotiated between the owner and the provider and set to within industry acceptable parameters; and (4) means for providing a warranty by the provider on the long-term capital equipment or fixtures in conjunction with the purchase by the owner of performance by the (1)-(3) means, said providing of the warranty including transferring from the owner to the provider the technical and financial risk including costs associated with managing and maintaining all components of the long-term capital equipment or fixtures within the standard of performance during the specified period of time.

In a further embodiment, the present invention as recited in claim 10 is directed to A computer program product for a third party provider to guarantee the performance of long-

the internal processor of the device itself monitors the status of its serviceable components so that the device can then notify a user when servicing of those components is needed (see for example, col. 2, lines 27-65; col. 3, lines 22-27; and col. 7, lines 14-22). Otherwise, Borg '634 at best discloses an otherwise conventional warranty that only covers specific serviceable components where the risks and costs are still on the user of the device.

Neither of these references, either alone or in combination, discloses, teaches or suggests, among other features, any method, software or structure wherein (1) existing conditions of long-term capital equipment or fixtures are diagnosed by the provider to determine if any repairs are required to bring the long-term capital equipment or fixtures to a predetermined start-up standard of performance, said predetermined start-up standard of performance being negotiated between the owner and the provider; (2) the long-term capital equipment or fixtures are repaired by the provider to reach the start-up standard if any of the existing conditions are below the predetermined start-up standard; (3) a maintenance schedule is developed by the provider to perform recurrent inspections, preventive maintenance, and housekeeping on the long-term capital equipment or fixtures so as to maintain the long-term capital equipment or fixtures at a standard of performance for a specified period of time, said standard of performance being negotiated between the owner and the provider and set to within industry acceptable parameters; and (4) a warranty is provided by the provider on the long-term capital equipment or fixtures in conjunction with the purchase by the owner of performance of the (1)-(3) steps, where the warranty includes transferring from the owner to the provider the technical and financial risk including costs associated with managing and maintaining all components of the long-term capital equipment or fixtures within the standard of performance during the specified period of time. In fact, the teaching in Borg '634 regarding the monitoring and maintenance of the device and the warranty applicable thereto is completely inconsistent with the present invention. Borg '634 is a conventional warranty covering only selected serviceable components. Borg '634 by itself cannot anticipate or render obvious every feature of the present invention, and thus falls far short of providing any teaching or suggestion that would make up for the deficiencies in Sakaguchi '359.

In addition, Applicants are in the process of obtaining testimonials from clients and those of skill in the art attesting to the novelty of the invention in the industry and to the commercial success of the invention. Said testimonials will be submitted to the Examiner in due course via supplemental response as soon as available.

All in all, the present invention as now claimed is distinguishable and thereby allowable over the rejection raised in the Office Action. The withdrawal of the outstanding prior art rejections is in order, and is respectfully solicited.

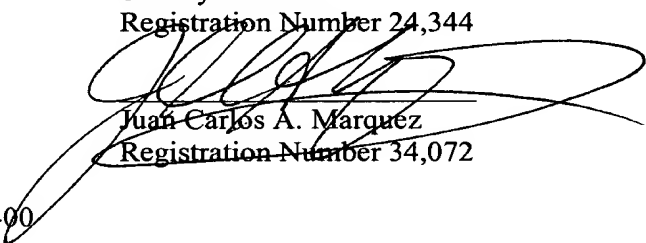
Conclusion

In view of all the above, clear and distinct differences as discussed exist between the present invention as now claimed and the prior art reference upon which the rejections in the Office Action rely, Applicants respectfully contend that the prior art references cannot anticipate the present invention or render the present invention obvious. Rather, the present invention as a whole is distinguishable, and thereby allowable over the prior art.

Favorable reconsideration of this application is respectfully solicited. Should there be any outstanding issues requiring discussion that would further the prosecution and allowance of the above-captioned application, the Examiner is invited to contact the Applicants' undersigned representative at the address and phone number indicated below.

Respectfully submitted,

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SPF/JCM